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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/368, 572 08/05/99 OHBA

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001444 HM22/0726  
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WASHINGTON DC 20001-5303

EXAMINER

CHUNDURU, S

ART UNIT	PAPER NUMBER
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1656

*6*

DATE MAILED:

07/26/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Offic Action Summary</b>	Application No.	Applicant(s)
	09/368,572	OHBA ET AL.
	Examiner	Art Unit
	Suryaprabha Chunduru	1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 09 July 2001.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-12 is/are pending in the application.

4a) Of the above claim(s) 1,2 and 7-12 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 3-6 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s): \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. The Preliminary amendment/ Pro Information Disclosure statement (Paper No. 2) filed on 8/05/99 has been entered and considered.
2. Applicant's election of Group II without traverse is acknowledged. Claims 3-6 in Group II were elected by the applicants and these claims are considered in this action for examination.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- a) Claim 3 and 5 are indefinite over the recitation of "capable of expressing" because capability is a latent characteristic and the claims do not set forth the criteria by which to determine capability. That is, it is not clear whether the recited cells have the potential to express or do in fact do express in the recited target. Amendment of the claim to read, for example, "which express" would obviate this rejection.
- b) Claims 3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the instant claims the term "useful gene" is not adequately defined and it reads on a broad number of genes. Further it is not clear what genes are useful for ligating to the promoter. Thus the instant claims 3 and 5 are unclear and vague and does not clearly set forth the metes and bounds of the claims.
- c) Claim 3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP

§ 2172.01. Method claims require a last step or phrase in the last step that states the accomplishment of the goals for the method which were stated in the method's preamble. Claim 3 and 5 lack such a last step (how controlling the morphology of a plant or transgenic plant is achieved) and is confusing because the additional method step is not sufficiently set forth. While minute details are not required in method claims, at least the basic steps must be recited in a positive, active fashion. See Ex parte Erlich, 3 USPQ2d1011, p.1011 (Bd. Pat. App. Int. 1986). It is suggested that an amended claim more clearly describing the intended steps be submitted.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 3-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishitani et al. (USPN. 5,516,694).

Nishitani et al. teach a method for regulating (controlling) the morphology of a plant wherein Nishitani et al. disclose that the method comprises transforming a plant with endoxylogucan transferse promoter (specific for organ or tissue or to a specified stage of the life cycle) ligated to a constitutive promoter originating in another gene (useful gene) in such a manner as to allow the expression of a gene encoding endo-xyloglucan transferase and its activity (see column 13, lines 27-65 and column 14, lines 8-41). The cassette for expression of endoxylogucan transferse includes vector (see column 13, lines 7-26). Further Nashitani et al. disclose transgenic plants and regeneration of transformed plants (see column 30, lines 30-67,

column 31, lines 1-67, column 32, lines 1-67, column 33, lines 1-67 and column 34, lines 1-34).

Hence the disclosure of Nishitani et al. meets the limitations in the instant claims 3-6.

No claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryapratha Chunduru whose telephone number is 703-305-1004. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on 703-308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0294 for regular communications and - for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

*SC*  
Suryapratha Chunduru  
July 17, 2001

  
JEFFREY FREDMAN  
PRIMARY EXAMINER